

REMARKS

Re-examination and reconsideration of the subject matter identified in caption, pursuant to and consistent with 37 C.F.R. §1.116, and in light of the remarks which follow, are respectfully requested.

Claims 1-20 are currently pending in this application. Claims 1, 4 and 11-15 stand withdrawn from consideration on the merits.

Turning to the Office Action, claims 2, 3, 5, 6, 9 and 16-20 were finally rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 6,015,570 to Tucci et al. in view of U.S. Patent No. 4,783,354 to Fagan. Reconsideration of this rejection is respectfully requested for at least the reasons which follow.

The presently claimed invention is directed to glass fiber wall coverings which are readily strippable from the substrates to which they are applied. The wall coverings include a glass fiber fabric coated on both sides with a dried aqueous dispersion containing a starch and a polymer latex binder, and having a second coating on one side consisting essentially of a paraffin wax and a rheology modifier. The second coating serves as a separation layer which enables the wall covering to be readily removed from the substrate to which it is attached.

Tucci et al. '570 relates to the preparation of slow-release insect-repellant compositions and articles manufactured therefrom. The compositions are coated on fabrics for use in manufacturing articles of clothing, tents and related uses designed for outdoor activity. The Examiner has referred to the disclosure of wall and floor coverings in the reference. However, that disclosure does not relate to coated fabrics but to compositions destined for application to wall and floors as paints, caulking formulations, etc.

"Furthermore, a longer-term repellency can be obtained when such capsules are used in the manufacture of commercial finishes such as caulking compositions, paint sealers, wall and floor coverings, and the like." (Column 10, lines 55-58)

Clearly, this sentence does not suggest the use of coated fabrics as wall and floor coverings but rather the use of coating formulations for application to walls and floors to provide longer-term insect repellency.

Additionally, the insect-repellant fabrics disclosed in Tucci et al. '570 do not contain a second layer on one side consisting essentially of a paraffin wax and a rheology modifier.

Tucci et al. '570 does not disclose or suggest applying a layer which would enable one to readily remove the wall covering.

In summary of the above, Tucci et al. '570 (1) does not disclose or clearly suggest applying coated fabrics to walls, and (2) does not disclose or suggest strippable fabric wall covering having a coating on one side consisting essentially of a paraffin and a rheology modifier. The secondary reference to Fagan '354 does not supply the aforementioned deficiencies in Tucci et al. '570.

Fagan '354 relates to wall coverings which have a pressure-sensitive adhesive layer containing a wax. The adhesive layer enables one to adhere the wall covering to a surface but the bond is not permanent and the wall covering can be readily removed from the surface. The pressure sensitive adhesive layer is essentially composed of a major proportion of an adhesive polymer and a minor amount of a wax. The weight ratios of polymeric adhesive to wax ranges from 10:1 to about 30:1 (column 3, lines 50-52). Thus, the wall coverings disclosed in Fagan '354 have a pressure-sensitive adhesive layer containing large amounts of adhesive polymer and are not permanently affixed to a substrate. To the contrary, the presently claimed wall coverings are designed to be adhered to substrates in the conventional manner of applying wallpaper, i.e. by using adhesive pastes and similar bonding mechanisms. The back layer consists essentially of a paraffin wax and provides the wall covering with the property of being readily strippable when the wall covering is to be removed.

To support a rejection under 35 U.S.C. §103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The motivation to modify the relied on prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. *In re Napier*, 55 F.2d 610,613; 34 U.S.P.Q.2d 1782,1784 (Fed. Cir. 1995). Obviousness cannot be established by modifying the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the modification. *In re Geiger*, 815 F.2d 686,688; U.S.P.Q.2d 1276,1278 (Fed. Cir. 1987).

Tucci et al. '570 does not disclose fiberglass wall coverings but only fabrics coated with insect repellant for use as garments, tent coverings, and other outdoor uses. Accordingly, there would have been no motivation to apply the pressure-sensitive adhesive backing layers of Fagan '354 to the coated fabrics of Tucci et al '570. Nor would there be a reasonable expectation of success, i.e. applying a pressure-sensitive layer to the coated

fabrics of Tucci et al. '570 would render the fabrics inoperative for the intended outdoor uses, i.e. sporting, farming, hunting (column 10, line 64). Thus, the application of a wax-containing pressure-sensitive adhesive layer upon an insect-repellant coating would cover the coating and render it useless for its intended purpose.

Moreover, even if one combined the respective teachings of these references, all the features of the present claims would not be met. The strippable coating specified in the present claims consists essentially of a paraffin wax and a rheology modifier. The language "consisting essentially of" excludes ingredients which would materially change the basic and novel characteristics of the claimed invention (M.P.E.P. §2111.03). Clearly, the presence of a major amount of a tacky polymer as in the pressure-sensitive adhesive layers of Fagan '354 would materially change the basic and novel characteristics of the paraffin wax-containing coatings of the present invention.

In response to Applicants' argument that the amount of paraffin wax specified in claim 19 is far removed from the amounts disclosed in Fagan '354, the Examiner argues that "the use of a higher weight percentage of wax is a result of optimization of the Fagan reference" (page 3, paragraph 8 of the Office Action). The optimum amount of wax disclosed in Fagan '354 is the "most preferably" ratio of adhesive to wax of about 15:1 (column 3, line 53). On the other hand, the amount of paraffin wax specified in claim 19 is at least 80% by weight. This amount is significantly different from the optimized amount of wax in the pressure-sensitive adhesive layer of the reference.

In paragraph (9) of the Office Action, the Examiner asks how the presence of a pressure-sensitive adhesive would affect the basic and novel characteristics of the present invention. The paraffin wax-containing coatings of the presently claimed wall coverings are not adhesives which are intended to permanently bond the wall coverings to a substrate. The wall coverings of the invention are bonded to substrates in the customary manner of any conventional wallpaper, i.e. using pastes, water-based adhesives, etc. Note page 7, paragraph [0031] of the specification. The pressure-sensitive adhesive layers in the wall coverings of Fagan '354 are designed to permanently bond the wall coverings to substrates, i.e. they replace the adhesives and pastes customarily used for this purpose; note column 1, lines 14-53 thereof. Thus, adding a significant amount of pressure-sensitive adhesive to the paraffin wax-containing coatings of the present wall coverings would subvert the coatings from a non-adhesive back layer which provides a strippable characteristic to a pressure-sensitive adhesive layer which permanently bonds the wall coverings to substrates.

For at least the above reasons, the §103(a) rejection based on Tucci et al. '570 in view of Fagan '354 should be reconsidered and withdrawn. Such action is earnestly requested.

Claim 10 stands rejected under 35 U.S.C. §103(a) as obvious over Tucci et al. '570 in view of Fagan '354 and further in view of U.S. Patent No. 3,640,743. Reconsideration of this rejection is respectfully requested.

Sheehan '743 has been relied on solely for a disclosure of using titanium dioxide as a pigment in preparing laminates for use as wall coverings. The reference fails to supply the aforementioned deficiencies in the basic combination of Tucci et al. '570 in combination with Fagan '354. As such, the §103(a) rejection of claim 10 should be withdrawn for at least the reasons fully set forth above.

Claims 7, 8 and 17 were again rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 4,148,781 to Narukawa et al. in view of Fagan '354. Reconsideration of this rejection is respectfully requested for at least the following reasons.

The wall coverings disclosed in Narukawa et al. '781 are sheets molded from compositions composed primarily of calcium sulfate dihydrate, i.e. gypsum. These products are clearly not coated glass fiber fabrics. The optional addition of glass fiber mats or fabrics (column 4, line 42) does not change the character of the gypsum sheet; the sheet is not a textile product and would be so recognized by those skilled in the art.

The sheets disclose in Narukawa et al. '781 are referred to therein as "building materials." No disclosure is seen in the cited art which would motivate one to apply a pressure-sensitive adhesive to the building materials of Narukawa et al. '781 nor would there be a reasonable expectation that such a modification would be successful.

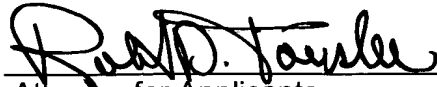
In paragraph (10) of the Office Action, the Examiner argues that the products of Narukawa et al. '781 can contain glass paper, glass mat or glass cloth and thus, can be "equated" to Applicants' glass fiber fabric. Respectfully, Applicants disagree. Adding a glass paper or mat or cloth to the building sheets of the reference presumably for reinforcement, does not change the character of the gypsum products. They are not fabrics as that term is understood by those of ordinary skill in the art, i.e. a textile composed of fibers or filaments.

For at least the above reasons, the §103(a) rejection based on Narukawa et al. '781 in combination with Fagan '354 should be reconsidered and withdrawn. Such action is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any

questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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